

REMARKS

Claims 1 through 10, 12 through 17 and 19 through 22 are pending in the application. Claims 11 and 18 have been canceled and Claims 12, 19 and 20 have been amended. Bases for the amendments may be found throughout the specification, claims and drawings as originally filed and as such, no new matter has been presented. The Examiner is respectfully requested to reconsider and withdraw the rejection in view of the amendments and remarks contained herein.

ALLOWABLE SUBJECT MATTER

Claims 1 through 10 are have been allowed. The Examiner states that Claims 12 through 17 and 19 through 22 would be allowable if rewritten in independent form. Accordingly, Applicant has rewritten Claims 12, 19 and 20 in an independent form, which includes the limitations of the base claim and any intervening claims. Accordingly, Applicant respectfully submits that Claims 12 through 17 and 19 through 22 are in condition for allowance.

Despite Applicant's cancellation of Claims 11 and 18 and presentation of Claims 12, 19 and 20 in an independent form, Applicant notes that it does not acquiesce in the rejection of Claims 11 and 18 under 35 U.S.C. §102(b) in view of U.S. Patent No. 4,050,281 to Sibling. In this regard, Applicant notes that the Examiner's basis for the rejection constitutes the same type of "probabilities and possibilities" that are expressly prohibited under the U.S. Patent Laws. *See, e.g., In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis in original)).

Applicant has specifically noted that Claim 1, lines 21 through 36 of Sibling provide:

...connected with the extrusion crosshead, a hollow stem mounted on the extrusion crosshead and extending forward therefrom in axial alignment with said container passage for insertion therein, the extrusion crosshead having

an opening through it behind the stem, a mandrel holder carried by the piercer crosshead and extending forward through said opening, a mandrel in said stem supported by said mandrel holder and having a tip at its front end of smaller diameter than the mandrel body behind it, means for supplying hydraulic fluid to the rear ends of the piercer cylinders while fluid is locked in the coupling cylinders to move said stem forward to the billet container, means for then exhausting fluid from the coupling cylinders to permit the forwardly moving piercer crosshead to move the mandrel forward from the stem into said container, stops behind...

(emphasis added). Applicant notes that the only relevant part of Claim 1, lines 21 through 36 of the Sibler reference is that which is underlined - "a hollow stem ... in axial alignment with said container passage for insertion therein". Applicant notes that the Sibler reference does not teach or suggest any method by which the stem is aligned to the container.

In contrast Claim 11 of the present application recites that the container is aligned directly to an axis of the stem. One way in which this may be accomplished is illustrated in Figure 8 of the present application. As noted in paragraph [0011] of the present application, prior methodologies for aligning components of an extrusion press align the individual components of the extrusion press to a predetermined point or axis, such as the longitudinal axis of the extrusion press. In contrast, the methodology of Claim 11 directly aligns the container to the stem without reliance upon a tertiary axis. Consequently, the methodology of Claim 11 is relatively quicker and tends to provide better alignment accuracy.

As the Sibler reference notes that the stem is axially aligned to the container but does not teach or suggest how this may be accomplished, Applicant submits that the Examiner has not presented a prima facie case of anticipation and that the Examiner has improperly attempted to invoke the theory of inherency. "Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art

reference must disclose each element of the claimed invention “*arranged as in the claim*”. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984).

Under the principles of inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is anticipated. *In re King*, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986). The Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

In this regard, the CCPA has added that “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis in original)).

Applicant respectfully submits that the Sibler reference does not teach or suggest any method by which the stem and the container are aligned to one another. As such, any remarks concerning how the stem and the container are aligned to one another in the Sibler reference can only be “probabilities or possibilities” that are not sufficient to prove inherency.

Accordingly, Applicant submits that the Examiner has not presented a prima facie case of anticipation and that the theory of inherency cannot be relied upon to “fill the gaps” in the Sibler reference since the Examiner cannot show that Applicant’s method is necessarily employed to achieve alignment of the stem and the container.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Dated: January 21, 2005

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